

RESPONSE TO RESTRICTION REQUIREMENT

Appln. No.: 09/481,069

At the outset, Applicant notes that, even under the Examiner's proposed grouping, claims 13-17, which depend from claim 1 and do not recite "an index or a table of content" (albeit do not exclude such an implementation from the scope thereof), were erroneously included in Group II.

Thus, in response to the Examiner's restriction requirement, Applicant elects Group I, claims 1-7, 13-17, 19-38, 49-54, 58, 61-66, 68-79, 91-98, 102, 107-108, 110, 112 and 113.

Applicant's election is with traverse: MPEP 803 provides a two-prong test for judging whether a restriction requirement is proper:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The invention must be independent ... or distinct as claimed ...; and

(B) There must be a serious burden on the Examiner if restriction is required ...

(*See Id.*, internal citations omitted).

In the present case, the Examiner failed to satisfy at least prong (B) of the test set forth in MPEP 803. That is, the Examiner alleges that the search required for each one of the Groups proposed by the Examiner is not required for the remaining groups. However, the Examiner has already performed searches for all of the groups, as evidenced by the four Office Actions on the merits (see Office Actions dated May 9, 2001, December 21, 2001, August 26, 2002 and December 4, 2002). In fact, in the last three Office Actions, the Examiner addressed the same claims 1-113 which are now subject to the restriction requirement. Furthermore, there have been two Examiner Interviews on the merits conducted on June 19, 2001 and November 5, 2002. Clearly, the Examiner cannot now maintain that these same claims impose "a serious burden" on the Examiner and require restriction.

Notwithstanding the foregoing, 37 C.F.R. § 1.142 (a) provides that, a restriction requirement "will normally be made before any action on the merits; however, it may be made at any time before final action" (*see Id.*, emphasis added). MPEP 811.02 explains that "restriction is proper at any stage of prosecution up to final action" (*see Id.* emphasis added). In the present

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case, the Examiner has issued **two final Office Actions**, addressing the same claims 1-113 which are now subject to the restriction requirement (see Office Actions dated December 21, 2001 and August 26, 2002). Indeed, the Examiner subsequently issued another Office Action, dated December 4, 2002 addressing these same claims. In fact, Applicant filed an Appeal Brief on June 4, 2003 appealing from the rejections of these same claims 1-113.

Thus, Applicant respectfully requests that the restriction and election requirements are improper and should be withdrawn.

Finally, since the Examiner has now withdrawn all of the rejections on the merits, Applicant respectfully requests indication of immediate allowance of at least the elected claims.

Respectfully submitted,



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